

### **REMARKS**

Claims 1-29 remain in the application. Claims 1, and 24 have been amended. The specification has been amended to correct some minor issues. Applicant respectfully requests reconsideration.

### **SPECIFICATION**

The Office Action objected to the use of the Java™ trademark without the appropriate designation. Applicant has corrected this, but disagrees with the Examiner that Java™ should be written in all capital letters. A quick glance at [www.java.com](http://www.java.com) or the Sun Microsystems, Inc. website, [www.sun.com](http://www.sun.com), reveals the trademarked logo with only initial caps. Therefore, Applicant submits that the amended form of the word is acceptable to the owner of the mark.

### **CLAIM REJECTIONS UNDER 35 USC §112**

The Office Action rejected claims 24-29 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.. Claim 24 has been amended to provide proper antecedent basis for “a product.”

### **CLAIM REJECTIONS UNDER 35 USC §101**

The Office Action rejected claims 16-23 under 35 USC 101 as being directed to non-

statutory subject matter. Specifically, claim 16 recites “a program product in a signal bearing medium...” The Examiner at page 2 reads into the claims a definition for this signal bearing medium from the specification at page 14, lines 1-14 as “transmission type media such as ... wireless communication links using transmission forms such as, for example, radio frequency and light wave transmissions...” The Examiner contends that such embodiments are non-statutory. It is improper to import limitations from the specification into the claims. Becton Dickinson v. CR Bard, Inc., 922 F.2d 792 (Fed. Cir. 1990).

The subject matter patentability analysis begins with the statute. Section 101 provides:

“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”

Claim 16 is directed at the statutory category of “manufacture.” See In re Beauregard, 53 F.3d 1583 (Fed. Cir 1995).

Excluded from patent protection are laws of nature, physical phenomena, and abstract ideas. *Diamond v. Diehr*, 450 U.S. 175 (1981). The United States Court of Appeals for the Federal Circuit has noted that the repetitive use of the expansive term “any” in § 101 shows Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in § 101. State Street Bank & Trust Co. v. Signature Fin. Group, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998). It is improper to read limitations into § 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations. See Chakrabarty, 447 U.S. at 308. “The Federal

Circuit has also cautioned that courts 'should not read into the patent laws limitations and conditions which the legislature has not expressed.'" State Street Bank & Trust Co. v. Signature Fin. Group, supra. The Office Action has not carried its burden of showing that any of the claims is directed at one of the foregoing judicially recognized exceptions to patentability.

### **CLAIM REJECTIONS UNDER 35 USC §102**

The Office Action rejected claims 1-29 under 35 USC 102(e) as being anticipated by US Patent Application 2003/0037316 to Kodosky, et al. For a reference to anticipate a claim, each element and limitation of the claim must be found in the reference. Hoover Group, Inc. v. Custom Metalcraft, Inc., 66 F.3d 299, 302 (Fed. Cir. 1995).

As to claim 1, Kodosky neither teaches nor suggests the claimed steps of “determining an object containment hierarchy (OCH)” or annotating the OCH with a temporal flow hierarchy (TFH). Kodosky relates to a system and method for creating and using configuration diagrams. Configuration diagrams are not the same as or an equivalent to an OCH or a TFH. The OCH is determined based on a program. By contrast, the configuration diagrams of Kodosky represent the configuration of systems. See Kodosky, paragraph [0009], line 3; paragraph [0010] line 3 (“representing a system”).

Assuming *arguendo* that the OCH could be said to read on a configuration diagram (which Applicant denies, as above) there is no mention in Kodosky of any annotation with temporal flow hierarchy. The only mention of an annotation is at paragraph [0466]: “The user

can annotate his diagram with additional free-form information.” That says nothing about annotating the OCH with a temporal flow hierarchy (TFH) as required by claim 1.

Claim 2 is dependent on claim 1 and is not anticipated by Kodosky for at least the same reasons that claim 1 is not anticipated by Kodosky.

Claims 3 and 7 are dependent on claim 2 and are not anticipated by Kodosky for at least the same reasons that claim 2 is not anticipated by Kodosky.

Claims 4 and 5 are dependent on claim 3 and are therefore not anticipated by Kodosky for at least the same reasons that claim 3 is not anticipated by Kodosky.

Claim 6 is dependent on claim 4 and is not anticipated by Kodosky for at least the same reasons that claim 4 is not anticipated by Kodosky.

Claim 8 is a system (machine) claim which comprises a limitation of instructions for “determining a program hierarchy for a program” wherein the program hierarchy comprises an OCH and a TFH. As shown above, Kodosky neither teaches nor suggests these limitations.

Claims 9, 14, and 15 are dependent on claim 8 and are not anticipated by Kodosky for at least the foregoing reasons.

Claim 10 is dependent on claim 9 and is not anticipated by Kodosky for at least the foregoing reasons. Claims 11, 12, and 13 are dependent on claim 10 and are not anticipated by Kodosky for at least the foregoing reasons.

Claim 16 is a manufacture claim that comprises instructions for determining a program hierarchy wherein the program hierarchy comprises a combination of an object containment hierarchy and a temporal flow hierarchy of the target program. For reasons

discussed above, Kodosky neither teaches nor suggests those limitations.

Claim 17 is dependent on claim 16 and is not anticipated by Kodosky for at least the foregoing reasons. Claim 18 is dependent on claim 17 is not anticipated by Kodosky for at least the foregoing reasons.

Claims 19 and 23 are dependent on claim 18 and are not anticipated by Kodosky for at least the foregoing reasons.

Claim 20 is dependent on claim 19 and is not anticipated by Kodosky for at least the foregoing reasons. Claims 21 and 22 are dependent on claim 20 and are not anticipated by Kodosky for at least the foregoing reasons.

Claim 24 is an apparatus (machine) which comprises instructions for determining a program hierarchy wherein the program hierarchy comprises a combination of an object containment hierarchy and a temporal flow hierarchy of the target program. Those limitations are neither taught nor suggested by Kodosky.

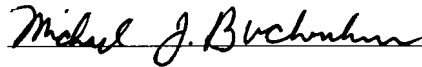
Claim 25 is dependent on claim 24 and is therefore not anticipated by Kodosky for at least the foregoing reasons.

Claims 26 and 29 are dependent on claim 25 and are not anticipated by Kodosky for at least the foregoing reasons. Claims 27 and 29 are dependent on claim 26 and are also not anticipated by Kodosky for at least the foregoing reasons.

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**Amendment I**

For the foregoing reasons, Applicant respectfully requests allowance of the pending claims.

Respectfully submitted,

A handwritten signature in cursive script, reading "Michael J. Buchenhorner", written in black ink.

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